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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,085	03/24/2004	John Ratzloff	1282.1101101	5362
28075 7590 08/06/2008 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420				
EXAMINER				
CULLER, JILL E				
ART UNIT		PAPER NUMBER		
2854				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/808,085

**Applicant(s)**

RATZLOFF, JOHN

**Examiner**

Jill E. Culler

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-11, 13-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-9, 15, 17 and 19 is/are allowed.
- 6) ☒ Claim(s) 10, 11, 13, 14, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The method of claim 21 is drawn to a method of providing a ready-to-bind photo page comprising providing rolls of paper, adhesive tape, and board material, sending unrolled layers of the materials through a page making machine to form a continuous sheet of material, and cutting the continuous sheet of material to create single pages sized for mounting in an album. As the originally claimed method is drawn to providing a single page rather than a continuous sheet, and contains none of these steps, the methods are considered to be patentably distinct.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10-11, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Truc et al. (4,911,777) and Emmel et al. (5,683,194).

With respect to claims 10 and 11, Hunter et al. teaches a method of providing a ready-to-bind photo sheet. As illustrated in Figure 5, Hunter teaches the step of providing an assembly, 110, of a blank, photo-printable sheet, 116, and a hinge strip, 114. Figure 5 further shows the hinge strip including a mounting portion, 120, formed of paper material, including a plurality of mounting holes, for mounting the mounting strip to an album. (See also column 6, lines 52-65) Figure 11 teaches the step of sending the assembly through a feed mechanism of a printer to print a photographic image on the blank sheet, wherein it is apparent that the mounting portion is flexible, such that the mounting portion does not disrupt this step. Hunter et al. further teaches the step of mounting the assembly in an album using the hinge strip. (See column 1.)

Hunter et al. does not teach that the hinge strip is spaced apart by a gap from the edge of the blank sheet and connected by connecting strips thereto, the connecting strips formed of a flexible, polymeric film.

Truc et al. teaches an assembly for mounting a photo sheet including a sheet, 12, and a mounting strip, 44, spaced apart from the edge of the sheet by a gap, 50, and connected by connecting strips thereto. See column 4, lines 1-16 and Fig. 6 in particular.

Emmel et al. teaches a mounting strip, 10, for mounting a sheet in an album including connecting strips, 11, formed of a flexible, polymeric film. See column 3, lines 1-9.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the assembly of Hunter et al. to have the gap and connecting strips, as taught by Truc et al., and to form the strips from a polymeric film, as taught by Emmel et al., in order to more securely and durably assemble the two pieces.

With respect to claim 16, although Hunter et al., Truc et al. and Emmel et al. do not explicitly teach the gap having a width in the range of about 0.375 inches, one having ordinary skill in the art would find it obvious that width of the gap would be dependent upon the relative sizes of the sheets and hinge strips and therefore the optimum size could best be determined through routine experimentation.

With respect to claim 18, although Hunter et al., Truc et al. and Emmel et al. do not explicitly teach the use of a photo-grade material, the applicant should note that insofar as structure is defined, the printer paper sheet 110 of Hunter meets this limitation, as a photo of good quality may be printed on the sheet. Furthermore the term photo-grade paper as broadly recited, does not define a cut-off requirement as to what quality of photo is enough to meet this limitation.

4. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 6,071,030) in view of Truc et al. (US 4,911,777) and Emmel et al.

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(5,683,194) as applied to claims 10-11, 16 and 18 above, and further in view of Tyler (US 4,207,366).

As outlined above, Hunter et al., Truc et al. and Emmel et al. teach all the claimed method steps, except the composition of the photo-grade sheet is not known.

With respect to claim 13, column 1, lines 35-54 of Tyler teach paper for printing, the paper comprising 100% cotton rag paper. Column 1, lines 35-54 also teach the use of neutral (acid-free) paper.

To one of ordinary skill in the art, it would have been obvious to use the paper taught by Tyler, in the method of Hunter et al., Truc et al. and Emmel et al. in order to provide dimensionally stable crush resistant paper, as taught in the abstract of Tyler.

With respect to claim 14, and the requirement for an acid free hinge strip, column 1 lines 48-54 teach the importance of neutral (acid-free) paper.

In view of this teaching of Tyler, it would have been obvious to one of ordinary skill in the art to make an acid-free hinge strip because neutrality in paper in the most important factor in paper permanence as taught by Tyler in column 1 line 50.

#### ***Allowable Subject Matter***

5. Claims 3-9, 15, 17 and 19 are allowed. The following is an examiner's statement of reasons for allowance:

The prior art fails to teach or render obvious the method of amended claims 3 and 19, particularly including providing an assembly including a blank sheet, a mounting strip, and first and second connecting strips, formed of a dissimilar material from the

mounting strip and separate from one another, adhesively attaching the first connecting strip along a first side of the mounting strip and the blank sheet, adhesively attaching the second connecting strip along a second side of the mounting strip and the blank sheet, such that the connecting strips span the gap between the mounting strip and the blank sheet, and sending the assembly through a printer to print a photographic image on the sheet.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

6. Applicant's arguments filed April 10, 2008, with respect to claims 10-11, 13-14, 16 and 18, have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's argument that Hunter teaches the binding edge region formed integral with the page, and therefore there would be no need for connecting strips to connect the binding edge region to the main body portion, does not apply to the current

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rejection, as Hunter is not relied upon for the teaching of the mounting strip as a separate element of the page.

In response to applicant's arguments that Truc does not teach an assembly for mounting in an album, Truc teaches two embodiments of an assembly for mounting a photo sheet and two methods of attaching a mounting strip in such an assembly. As argued by applicant, the assembly relied upon for teaching the claimed method is not the assembly which is taught for mounting in an album. However, one having ordinary skill in the art, being aware of both embodiments, would be drawn to modify the apparatus of Hunter to use either attachment method in order to supply greater support and flexibility to the sheets.

In response to applicant's argument that the mounting strip taught by Truc is made of metal and would not be able to pass through a printer, one having ordinary skill in the art would find this to be obvious and would be readily drawn to have the mounting strip portion formed of paper, as taught by Hunter, in order to maintain the functionality of the process. Again, the teachings of Truc are relied upon merely for teaching the mounting portion separate from the page and connected through connecting strips. One having ordinary skill in the art would be readily able to take these teachings and apply them to the method of Hunter in a reasonable manner.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-F 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jec

/Jill E. Culler/  
Primary Examiner, Art Unit 2854